



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

cel

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,784	04/21/2004	Donald M. Connelly JR.	SJO920030101US1	5055
45216	7590	03/06/2006	EXAMINER	
KUNZLER & ASSOCIATES 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111			BROUSSARD, COREY M	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,784

Applicant(s)

CONNELLY ET AL.

Examiner

Corey M. Broussard

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

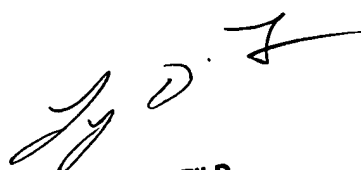
1. In view of the Appeal Brief filed on 12/22/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


LYNN FEILD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “receiver” and “storage device carrier” as defined in claim 23 must be shown or the features canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2835

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-11, and 13-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With respect to claims 1, 9, 18, 21 and 24, it is unclear how a surface may form a wall that supports the structure of the device. A surface itself lacks the structural support necessary to reasonably be considered a wall.

5. With respect to claim 23, it is unclear how to make/use a device wherein the receiver is secured to the mounting surface and receives the carrier, yet the carrier is between the receiver and the mounting surface.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 3-11, and 13-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims use the term "surface" in a way that seems improper and renders the scope of the claims unclear. "Surface" is generally defined as a substantially two dimensional external layer. The claims define the mounting surface as a composite of multiple layers.

8. With respect to claim 23, it is unclear how the receiver is secured to the mounting surface yet formed in the mounting surface, and how the storage device carrier can be between said receiver and said mounting surface.

Claim Objections

9. Claims 13 and 14 are objected to as being improper for depending on a canceled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 21, 24, 25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Pavol (PN 6,445,587). With respect to claim 21 as best as it can be understood, the method for reducing vibration is inherent in the structure of Pavol, Pavol teaches providing an enclosure chassis (104) configured to store at least one storage device (102), providing a mounting surface (interior surface of mounting bay 108) oriented vertically (the side walls of the bay are oriented vertically, see Fig. 3) and coupled to the enclosure chassis to form one wall of a drive bay (108), the mounting surface configured for receiving a horizontally oriented storage device carrier (106); providing a first layer on the mounting surface (128); providing a second layer on the

mounting surface (136); and providing a viscoelastic layer (126) disposed between the first and second layer of the mounting surface for reducing vibration propagation throughout the mounting surface; and providing an interface shelf oriented horizontally and coupled to the enclosure chassis (104) such that the interface shelf isolates horizontal storage device bays (108) above the interface shelf from storage device bays below the interface shelf (see Fig. 1 clearly showing a shelf between the upper and lower storage bays).

12. With respect to claim 24 as best as it can be understood, Pavol teaches an enclosure chassis (104) configured to store at least one storage device (102), a mounting surface (interior surface of mounting bay 108) oriented vertically (the side walls of the bay are oriented vertically, see Fig. 3) and coupled to the enclosure chassis to form one wall of a drive bay (108), the mounting surface configured to receive less than three horizontally oriented a storage device carriers (106, the mounting surface is configured to receive one carrier, which is less than three) and having a damping means (foam laminates comprising of elements 126, 128, and shelves 130, 132, 136) for damping the vibrational energy generated by the storage device and received by the mounting surface; and an interface shelf oriented horizontally and coupled to the enclosure chassis such that the interface shelf isolates horizontal storage device bays above the interface shelf from storage device bays below the interface shelf (see Fig. 1 clearly showing a shelf between the upper and lower storage bays).

13. With respect to claim 25 as best as it can be understood, Pavol teaches wherein the damping means comprises a first layer (128), a second layer (136), and a viscoelastic layer (126) between the first layer and the second layer.

14. With respect to claim 27 as best as it can be understood, Pavol teaches a receiving means (col 5 lines 65-66 col 6 lines 1-2) coupled to the mounting surface (interior surface of mounting bay 108) for receiving and retaining a storage device carrier (106) perpendicular to the mounting surface (see Fig. 1, 3, the carriers extend in a direction perpendicular from the surface of 128).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 3-6, 8, 9-11, 13, 14, 16, 17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavol (PN 6,445,587) in view of Anderson et al. (PN 6,209,842). With respect to claim 1 as best as it can be understood, Pavol teaches an enclosure chassis (104); a mounting surface (interior surface of mounting bay 108 outer surface of 128) oriented vertically (the side walls of the bay are oriented vertically, see Fig. 3) and coupled to the enclosure chassis to form one wall of a drive bay (108), the mounting surface configured to receive a horizontally oriented storage device carrier (106, the top and bottom of the carrier are oriented with the horizon, see Fig. 3), the

mounting surface having a first layer (128) and a second layer (136); a viscoelastic layer (126) disposed between the first layer and the second layer to reduce vibration propagation throughout the mounting surface. Pavol lacks specific teaching of a separate receiver structure. Anderson teaches an enclosure chassis with mounting bays (103, see Fig. 1); a storage device carrier (200); and a receiver (301) secured to the mounting surface (see Fig. 3, col 3, 50-56). It would have been obvious to a person of ordinary skill in the art to combine the disk drive system of Pavol with the rail system of Anderson for the benefit of storage device carriers guided by rails to mate with the connectors of the backplane.

17. With respect to claim 4 as best as it can be understood, Anderson teaches a second receiver (see Fig. 3 clearly showing multiple receivers) secured to the mounting surface, the second receiver configured to retain a second storage device carrier (see Fig. 3, each rail retains a separate carrier, col 3, 50-61).

18. With respect to claim 9 as best as it can be understood, Pavol teaches an enclosure chassis (100); a mounting surface (interior surface of mounting bay 108 outer surface of 128) oriented vertically (the side walls of the bay are oriented vertically, see Fig. 3) and coupled to the enclosure chassis to form one wall of a drive bay (108), the mounting surface having a first layer (128) and a second layer (136); a viscoelastic layer (126) disposed between the first layer and the second layer to reduce vibration propagation throughout the mounting surface; a first and second storage device carrier (106) configured to retain a storage device therein. Pavol lacks specific teaching of a separate receiver structure. Anderson teaches an enclosure chassis with mounting

bays (103, see Fig. 1); a storage device carrier (200); and a first and second receiver (301, see Fig. 3) secured to the mounting surface, the receivers configured to receive and retain the storage device carriers substantially perpendicular to the mounting surface (col 3, 50-61). It would have been obvious to a person of ordinary skill in the art to combine the disk drive system of Pavol with the rail system of Anderson for the benefit of storage device carriers guided by rails to mate with the connectors of the backplane.

19. With respect to claim 10 as best as it can be understood, Anderson teaches a spring (405, 600) configured to resiliently couple a storage device carrier (400) between the mounting surface (401 and 403) and the receiver (301), the spring having first and second ends configured to engage one of the storage device carrier and the mounting surface (see Fig. 4, one end engages the carrier with fastening means 407 and another end engages the mounting surface 401, 403). Anderson does not specifically teach a clip-on spring, but does state other mounting means may be used (col 4 lines 65-67). It would have been obvious to a person of ordinary skill in the computer art to combine the drive mounting system of Pavol with the laminated damping device of Anderson, utilizing any mounting means well known and old in the art such as a clip-on means, for the benefit of increased protection from vibrations.

20. With respect to claims 3 and 11 as best as they can be understood, Pavol teaches wherein an interface shelf oriented horizontally and coupled to the enclosure chassis (104) such that the interface shelf isolates horizontal storage device bays (108)

above the interface shelf from storage device bays below the interface shelf (see Fig. 1 clearly showing a shelf between the upper and lower storage bays).

21. With respect to claims 5 and 13 as best as they can be understood, Pavol teaches wherein the mounting surface is configured to receive the first storage device carrier (106) on one side of the mounting surface and the second storage device carrier on an opposite side of the mounting surface (see Fig. 1, clearly teaching that the carriers of the top and bottom row are received on opposite sides of the same mounting surface).

22. With respect to claims 6 and 14 as best as they can be understood, Anderson teaches the mounting surface is disposed to receive the first storage device carrier (200) on one side of the mounting surface and the second storage device carrier on a same side of the mounting surface as the first storage device (see Fig. 3, col 3, 50-61).

23. With respect to claims 8 and 16 as best as they can be understood, Pavol teaches the storage device (102) is a disk drive (col 3 line 26).

24. With respect to claim 17 as best as it can be understood, Anderson teaches wherein the clip-on spring (405, 600) comprises at least three layers (601, 603, 605) including at least one viscoelastic layer (605, see Fig. 6 and col 4 lines 35-36).

25. With respect to claim 23 as best as it can be understood, Pavol teaches the method as applied to claim 21 above, but lacks specific teaching of a separate receiver. The method for reducing vibration is inherent in the structure of Anderson. Anderson teaches providing a storage device carrier (400) for retaining a storage device, securing a receiver (301) to the mounting surface (401 and 403) for receiving the storage device

carrier; and coupling at least one damped spring (405, 600) to the storage device carrier, for resiliently coupling the storage device carrier between a receiver formed in the mounting surface and the mounting surface (the carrier is between both the receiver and the mounting surfaces, see Fig. 3-5). Anderson does not specifically teach a clip-on spring, but does state other mounting means may be used (col 4 lines 65-67). It would have been obvious to a person of ordinary skill in the computer art to combine the drive mounting system of Pavol with the laminated damping device of Anderson, utilizing any mounting means well known and old in the art such as a clip-on means, for the benefit of increased protection from vibrations.

26. Claims 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavol (PN 6,445,587) in view of Polch et al. (PN 5,858,509). With respect to claim 22 as best as it can be understood, Pavol teaches the method of claim 21 above, but lacks a viscoelastic layer disposed between the layers of the chassis other than in the mounting surface. The method of reducing vibration is inherent in the structure of Polch, Polch teaches providing a first layer (28) on the enclosure chassis (9); providing a second layer (26) on the enclosure chassis; and providing a viscoelastic layer (36, 38, 39, 40 are preferably 3M's ISD 112, see col 4 lines 19-20, see also attached reference from 3M's online catalog describing ISD 112 as a viscoelastic polymer) disposed between the first and second layer of the enclosure chassis (see Fig. 2), for reducing vibration propagation throughout the enclosure chassis. It would have been obvious to a person of ordinary skill in the computer art to combine the mounting shelf of Polch

with the mounting enclosure of Pavol to obtain a drive mounting system for the benefit of increased vibration attenuation.

27. With respect to claim 26 as best as it can be understood, Pavol teaches the device as applied to claim 25 above, but lacks where the viscoelastic layer is a damping adhesive. Polch teaches using an acrylic adhesive layer (see col 4 lines 19-20, see also attached reference from 3M's online catalog describing ISD 112 as a viscoelastic damping polymer). It would have been obvious to a person of ordinary skill in the computer art to use any available suitable material for the viscoelastic layer of Pavol, such as the acrylic adhesive suggested by Polch for the benefit of a damping means that bonds itself to a surface thereby simplifying construction.

28. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavol (PN 6,445,587) in view of Anderson et al. (PN 6,209,842) and in further view of Polch et al. (PN 5,858,509). With respect to claim 7 and 15 as best as they can be understood, Pavol in view of Anderson teaches the device as applied to claim 1 and 9 above, but lacks a viscoelastic layer disposed in the enclosure chassis other than in the mounting surface. Polch teaches an enclosure (9) for storing at least one storage device (8), comprising a viscoelastic layer (36, 38, 39, 40 are preferably 3M's ISD 112, see col 4 lines 19-20, see also reference cited from 3M's online catalog describing ISD 112 as a viscoelastic polymer) disposed between a first layer (28) and a second layer (26) of the enclosure chassis (see Fig. 2). It would have been obvious to a person of ordinary skill in the computer art to combine the mounting shelf of Polch as modified by

Anderson with the mounting enclosure of Pavol to obtain a drive mounting system for the benefit of increased vibration attenuation.

29. Claims 18 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavol (PN 6,445,587) in view of Bell et al. (PN 6,775,142). With respect to claim 18 as best as it can be understood, Pavol teaches an enclosure chassis (104), a mounting surface (interior surface of mounting bay 108 outer surface of 128) oriented vertically (the side walls of the bay are oriented vertically, see Fig. 3) and coupled to the enclosure chassis to form one wall of a drive bay (108), the mounting surface having a first layer (128) and a second layer (136) and a viscoelastic layer (126) disposed between the first layer and the second layer to reduce vibration propagation throughout the mounting surface, the mounting surface configured to receive less than three horizontally oriented storage device carriers (106, the mounting surface is configured to receive one carrier, which is less than three) substantially perpendicular to the mounting surface (see Fig. 1, 3, the carriers extend in a direction perpendicular from the surface of 128); interface shelf oriented horizontally and coupled to the enclosure chassis (104) such that the interface shelf isolates horizontal storage device bays (108) above the interface shelf from storage device bays below the interface shelf (see Fig. 1 clearly showing a shelf between the upper and lower storage bays); a storage device carrier (106) including a bezel (116, the broadest reasonable definition of bezel in the computer art is: "a cover"; 116 covers a side of the drive 102, see Fig. 2), the storage device carrier configured to retain a storage device (102) therein, the storage device having a storage device carrier interface (138). Pavol lacks a key removably secured

on the bezel. Bell teaches a key (24, 21) removably secured to at least one of two positions on the bezel (124, see Fig. 3), such that placement of the key (21, 24, etc.) into one of the two positions prevents the storage device carrier interface from contacting an incompatible interface upon inserting the storage device carrier into the enclosure chassis (see Fig. 3, 9, 10, col 7, 16-24). It would have been obvious to a person of ordinary skill in the computer art to combine the drive vibration attenuation system of Pavol with the key system of Bell to obtain a drive system where the device carriers are selectively keyed to fit selected bays for the benefit of a system that prevents a user from inadvertently matching one device type with an incompatible type and also provides vibration attenuation.

30. With respect to claim 28 as best as it can be understood, Pavol teaches the device as applied to claim 24 above, but lacks a bezel with a keying means. Bell teaches a bezel (124, the broadest reasonable definition of bezel in the computer art is: "a cover"; see Fig. 3) secured to the storage device carrier (120) and configured to lock the drive carrier within the enclosure; and a keying means (pins 21, 24, etc. and holes for said pin, see Figs. 1, 2, col 6, 51-64), attached to the bezel (see Fig. 4), for preventing a storage device carrier, with one type of interface, from contacting an incompatible interface upon inserting the storage device carrier into the enclosure chassis (see Fig. 4, 8, 9, 10, col 7, 16-24). It would have been obvious to a person of ordinary skill in the art to combine the drive vibration attenuation system of Pavol with the key system of Bell to obtain a drive system where the device carriers are selectively keyed to fit selected bays for the benefit of a system that prevents a user from

inadvertently matching one device type with an incompatible type and also provides vibration attenuation.

31. With respect to claim 29 as best as it can be understood, Bell teaches wherein the keying means (pins 21, 24, etc. and holes for said pin, see Figs. 1, 2, col 6, 51-64) for keying a storage device carrier (120) comprises a key (21, 24, etc.) removably secured to at least one of two positions on the bezel (124, see Fig. 3), and wherein the placement of the key into one of the two positions prevents the storage device carrier interface from contacting an incompatible interface upon inserting the storage device carrier into the enclosure chassis (see Fig. 4, 8, 9, 10, col 7, 16-24).

32. With respect to claim 30, Bell teaches wherein the keying means for keying a storage device carrier comprises a groove in the enclosure chassis configured to receive the key (see Fig. 5, the key plate 135 may comprise grooves for accepting the keys 24, 21).

33. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavol (PN 6,445,587) in view of Bell at al. (PN 6,775,142) as applied to claim 18 above, and further in view of Anderson at al. (PN 6,209,842). With respect to claim 19 as best as it can be understood, Pavol as modified by Bell lacks specific teaching of a clip-on spring. Anderson teaches at least one spring (405, 600) coupled to the storage device carrier (400), the spring configured to flexibly couple the storage device carrier to the mounting surface (401, 403, see Fig. 4), the spring having first and second ends configured to engage one of the storage device carrier and the mounting surface (see Fig. 4, one end engages the carrier with fastening means 407 and another end engages

the mounting surface 401, 403). Anderson does not specifically teach a clip-on spring, but does state other mounting means may be used (col 4 lines 65-67). It would have been obvious to a person of ordinary skill in the computer art to combine the keyed drive mounting system of Pavol as modified by Bell with the laminated damping device of Anderson, utilizing any mounting means well known and old in the art such as a clip-on means, for the benefit of increased protection from vibrations.

34. With respect to claim 20 as best as it can be understood, Anderson teaches wherein the clip-on spring (405, 600) comprises at least three layers (601, 603, 605) including at least one viscoelastic layer (605, see Fig. 6 and col 4 lines 35-36).

Response to Arguments

35. Applicant's arguments, see Appeal Brief, filed 12/22/2005, with respect to the rejection of claims 1, 3-11, and 13-30 under 35 U.S.C. 102 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, new grounds of rejection are made in view of Pavol (PN 6,445,587), Bell et al. (PN 6,775,142), Anderson et al. (PN 6,209,842), and Polch et al. (PN 5,858,509).

36. With respect to the arguments that the functional limitations are not considered, the Examiner notes that functional limitations of apparatus claims are given little to no patentable weight. "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See MPEP 2114. Even if the functional

limitations implied some structural limitation, it is apparent that the prior art device functions in the same manner as the device of the claims. The Applicant seems to ignore the implicit teachings of the prior art. It is apparent that the mounting surface of Pavol is configured to receive the storage device carrier. The receiver is configured to retain the carrier perpendicular to the mounting surface. This is clearly shown in Figs. 1 and 2. The prior art does not have to contain the limitations of the claims verbatim in order to anticipate the claimed limitations.

37. With respect to the arguments concerning the orientation of the structural components, the Applicant alleges that a certain interpretation (described on pages 10 and 11) is how one of skill in the art would also interpret the claims. However, the prior art of record directly contradicts this view. Pavol states in col 5, lines 4-15 that, "Referring to FIG. 3, resilient layers 126 may also be positioned horizontally along opposing sidewalls 136 of the bay 108 in alternative embodiments." Given the teachings of the prior art, the Examiner cannot accept the view presented by the Applicant as the only view one of skill in the art would consider. Regardless of whether the characterization of horizontal and vertical taught by Pavol is traditional in the art, the teachings of Pavol at least suggest to a worker in the art that orientation is relative within the art. The Applicant refers to the benefit of the orientation of his invention as having a minimal height while retaining high storage density (Remarks filed 5/20/2005 page 15). Pavol also implicitly teaches this benefit in col 3, lines 16-19. Taking the teachings of Pavol into account, it would seem that within the drive enclosure art the same side of a device might be labeled as horizontal or vertical without affecting the

device itself. Therefore the horizontal and vertical limitations of the claims are not given any patentable weight.

38. The remaining arguments are believed to be moot in view of the new grounds of rejection presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey M. Broussard whose telephone number is 571 272 2799. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on 571 272 2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMB
cmb

Lynn Feild
LYNN FEILD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800